



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,720	04/01/2004	Roeland Nusse	STAN-299	1120
24353	7590	09/20/2005	EXAMINER	
BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303			CHISM, BILLY D	
			ART UNIT	PAPER NUMBER
			1654	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/816,720	Applicant(s) ROELAND NUSSE	
	Examiner B. Dell Chism	Art Unit 1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2005.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 7-11 and 13-16 is/are pending in the application.  
 4a) Of the above claim(s) 16 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 7-11 and 13-15 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☒ Claim(s) 16 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |




## **DETAILED ACTION**

### **Withdrawal of Objections and Rejections**

1. The rejections and/or objections made in the prior office action mailed on 07 April 2005, which are not explicitly stated below, in original or modified form are withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. Applicants' arguments filed 06 July 2005 will be addressed to the extent that they pertain to the present grounds of rejection.

### ***Specification***

2. (Maintained) The objection to the specification regarding the informalities of amino acid sequences lacking sequence identifiers (i.e., at page 25) is maintained, since the objection was not addressed in Applicant's response.

### ***Election/Restrictions***

3. (Necessitated by Amendment) Newly submitted claim 16 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new claim 16 would be a part of the Group I, which was not elected.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 16 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112***

4. (Withdrawal) Rejection of claims 7-11 under 35 U.S.C. 112, second paragraph, as being indefinite for claim 7 language of “isolating a Wnt protein” and the rejection of claims 8-11 for depending from the indefinite claim 7 is withdrawn.

***Claim Rejections - 35 USC § 102***

5. (Maintained) Rejection of Claim 7 under 35 U.S.C. 102(b) as being anticipated by Rodan et al. (US 5,780,291) is maintained. Rodan et al. claim an isolated and purified Wnt protein and the specification gives the methods for isolating and purifying the product. The specification was used in the rejection of the instant method claims, however, the Applicant argues that the specification in Rodan et al. is lacking enablement or written description regarding the methods for obtaining the Rodan et al. product. The examiner will note that all issued patents are presumed enabled and sufficiently described, among other things that do not apply instantly. The examiner has no reason to question that the isolated and purified Wnt of Rodan et al. is active or isolated or purified. The specification of the patent gives methods for isolating the protein and those methods are those methods that are instantly claimed. As to the lacking of minute method details used in the patent, the Applicant has not distinguished the instant claim 7 from the methods given in the specification of Rodan et al. The examiner does not question the activity of the Rodan et al. protein because it is reasonably presumed from the patent that the techniques used were sufficient for the isolation and purification of the Wnt protein. Finally, the limitations of the instant claim 7 are met by the teachings of the Rodan et al. specification.

***Claim Rejections - 35 USC § 103***

6. (Maintained in Part and Necessitated in Part) Rejections of Claims 7-11 and new claims 13-15 under 35 U.S.C. 103(a) as being unpatentable over Rodan et al. (US 5,780,291) in further view of Lambeth et al. (US 6,620,603 B1), Vernet et al. (US 6,653,448 B1), and Matthews et al. (US 6,159,462) are maintained.

As discussed above, the methods of Rodan et al. are considered patentable by weight and therefore the rationale of Rodan et al. in conjunction with Lambeth et al. and Matthews et al. is maintained. All methods and procedures are adequately taught with the required motivations to perform such procedures in the isolation and purification procedures as instantly claimed protein, especially where the protein is desired in a pharmaceutical. Applicant has not removed the nexus between the prior art references by attacking the validity of the Rodan et al. patent. Lambeth et al. and Matthews et al. serve well to show the motivation and technique for isolating, purifying and using protein such as taught by Rodan et al. Additionally, there is no reason to doubt the percent isolation and purity of the claimed protein in Rodan et al., especially where the same method limitations are applied in the methods. Therefore, the rejection is maintained.

***Conclusion***

7. No claims are allowed.

8. Applicant's amendment necessitated the maintenance of old grounds and new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

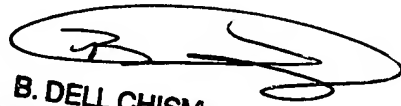
Art Unit: 1654

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. Dell Chism, whose telephone number is (571) 272-0962. The examiner can normally be reached on M-F 08:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campbell, PhD can be reached on (571) 272-0974.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BDC



B. DELL CHISM  
PATENT EXAMINER



BRUCE R. CAMPBELL, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600